REMARKS

Claims 1, 2, 4, 5, 7, 8, 10, 11, 13 – 17, and 20 – 30 are pending.

Rejections Under 35 U.S.C. § 103

Claims 1, 2, 4, 5, 7, 8, 10, 11, 13 – 17, and 20 – 30 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Babler et al. ("Babler"). The rejection is respectfully traversed for the following reasons.

Babler discloses use of continuous extraction for selective esterification of symmetric diols accomplished by treating the diols with a solution of aqueous acetic acid in the presence of a strong acid catalyst.

Applicants disclose a process for preparing a monoester comprising the step of reacting at least one diol with at least one carboxylic acid in a biphasic solvent system comprising water and at least one aprotic solvent, wherein the carboxylic acid has a water solubility that allows esterification to occur so as to form a resulting monoester having a greater solubility in the at least one aprotic solvent than in water. The reaction step is conducted as a batch process.

Applicants respectfully submit that the teaching of Babler fails to make obvious Applicants' claimed invention for at least the reason that Babler does not teach or suggest a process for preparing monoesters that is conducted as a batch process without a continuous extraction step.

The Examiner has asserted that "it is well-established that batch and continuous processes are not patentably distinct." To support this assertion, the Examiner has cited In re Dilnot, 319 F. 2d 188, 138 USPQ 248 (C.C.P.A. 1963). In re Dilnot, however, dealt with a specific factual situation and the C.C.P.A. does not appear to have held that batch and continuous processes are never patentably distinct.

The claim at issue in In re Dilnot (claim 22) was drawn to a method "of producing a cellular cementitious structure consisting of the steps of, preparing a slurry of cementitious material, generating a stable air foam, continuously introducing said foam with said slurry as said foam is introduced to produce a substantially uniform dispersion of said foam and in said slurry, introducing said mixed foam and slurry into a form of desired configuration, and allowing said mixture to set and harden." The appellant contended that the claim distinguished over the prior art

in requiring the addition of the foam to be continuous. The C.C.P.A. held that there was no patentable distinction over the prior art mode of delivering a measured volume of foam into a concrete mixer containing a slurry of cementitious material and distributing the foam into the mix. Essentially, the Court rightfully held that there was no patentable distinction between continuously adding foam into a simple mixing process and adding a "slug" of foam into a simple mixing process.

In contrast, the present invention deals with a much more complex process than a simple mixing process. Applicants have discovered a process for selectively transforming symmetric diols into monoacetates that is commercially viable and eliminates the necessity for specialized continuous extraction equipment.

The Examiner has asserted that "it would have been obvious to the skilled artisan in the art to be motivate [sic] to conduct the prior art process as a batch process as an alternative." The *prima facie* case for obviousness, however, requires "a reasonable expectation of success." See, e.g., MPEP § 2143.02. One of skill in the art at the time of invention would not have expected that a simple batch process could be used to selectively prepare monoesters such as, for example, monoacetates from symmetric diols. Babler, for example, teaches away from a batch process by teaching that monoacetates must be removed from the reaction mixture by continuous extraction with a suitable nonpolar solvent before they convert into undesirable diacetate derivatives (see, e.g., the bottom of page 1971 and the top of page 1973). Babler further teaches that his process could be improved by increasing the amount of acid catalyst, heating the reaction mixture, varying the ratio of water:acetic acid, and using a more efficient extractor [underlining added] (see footnote b, page 1972).

In view of the foregoing, Applicants' claimed invention is nonobvious and patentable over Babler. Applicants therefore respectfully request that the rejection under 35 U.S.C. § 103(a) be withdrawn.

Concluding Remarks

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration and allowance of the application is requested. Should the Examiner not view the claims as being allowable in view of the foregoing amendments and remarks, Applicants'

Attorney respectfully requests an opportunity to discuss any remaining issues by phone at the Examiner's convenience.

Respectfully submitted,

Oct. 5, 2007
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